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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,272	01/02/2004	Ronald Harrison	P-6214-04-03	1708
23983	7590	12/01/2005	EXAMINER	
MILLS LAW FIRM, PLLC P.O BOX 1245 Cary, NC 27512-1245			BRYANT, DAVID P	
		ART UNIT		PAPER NUMBER
		3726		

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/750,272	HARRISON, RONALD	
	<b>Examiner</b>	<b>Art Unit</b>	
	David P. Bryant	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

- (1) Reference character “**244**” has been used to designate both the drill units and the hydraulic actuator (see Figure 11). The hydraulic actuator should be renumbered as 248 to correspond to the specification on page 15, line 15.
- (2) Reference character “**250**” has been used to designate both a throughbore (in Figure 14) and the hold down plate (in Figures 13 and 14).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

#### **Page 1:**

In the second line of the paragraph entitled “Related Application,” the filing date of the

parent case is incorrect. It should be changed to --April 7, 2003--. Also, the data should be updated by including the patent number of the application.

Page 14:

In line 5, "2203" should be changed to --203--.

In lines 5-6, reference is made to "mobile assembly platform 204 including an indexing conveyor 206". However, there is no 204 in the drawings. Since the mobile assembly platform apparently *is* the indexing conveyor (note that lines 3-9 of page 15 disclose that the indexing conveyor contacts the base layer of timbers directly, with no type of intermediate platform), it is suggested that "204" be deleted.

Pages 15 and 16:

Reference character 250 has been used to reference both a throughbore (page 15, lines 19 and 22) and a hold down plate (page 16, line 14).

***Claim Objections***

**Claims 1, 3-7, and 12 are objected to because of the following informalities:**

Claim 1:

In line 13, "for" (second occurrence) should be deleted for clarity.

Claims 3-7:

In each of these claims, it is suggested that all occurrences of "assembly table" be changed to --assembly support-- to correspond to the claim language in independent claim 1.

Claim 12:

In line 15, "a" should be deleted for clarity.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Claim 1:**

Lines 6-9 recite a frame member, an assembly support *carried on said frame member*, and a gang drill assembly *supported on said frame member*. However, neither the embodiment of Figures 1 and 4, nor the embodiment of Figures 11 and 12, include both an assembly support *and* gang drill assembly *carried or supported* on the frame member. In fact, in both embodiments, while the gang drill assembly is supported on the frame member, the assembly support is a free-standing platform carried on its own support legs. Therefore, it is suggested that "carried on said frame member" be deleted from the portion that reads "an assembly support carried on said frame member" in lines 6-7.

**Claims 3 and 4:**

Claim 3 recites "said assembly table is longitudinally moveable" in line 2, while claim 4 recites "indexing conveyor means moving said assembly table" in lines 1-2. It is presumed that the "assembly table" being referred to is the "assembly support" recited in claim 1. However, the specification on pages 14-15 appears to disclose that the apparatus includes a fixed assembly

platform/table **230**, and an indexing conveyor **206** thereon that moves the timbers along the fixed platform/table. This discrepancy must be clarified. To do so, it is suggested that "table" be changed to --support-- in claim 3, and that "including indexing conveyor means for longitudinally moving said assembly table" be changed to  
--wherein said assembly support comprises indexing conveyor means for longitudinally moving said timbers-- in claim 4.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 1:**

In lines 1-2, "consisting of at least" is improper. Applicant is advised to either change "consisting" to --comprising--, or to delete "at least".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 11, 15, and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Phillips et al. (U.S. Patent No. 5,032,037) or Penland, Sr. (U.S. Patent No. 4,462,712).**

Both Phillips et al. and Penland, Sr. teach temporary road mats made up of at least three layers of transversely aligned timbers bolted together. In Phillips et al., see Figure 1; column 2, line 66, to column 3, line 4. In Penland Sr., see Figure 2; column 4, lines 33-47; column 5, lines 38-43.

Note that it is the resulting structure of the temporary road mat recited in claims 11 and 15 that is compared against the art of record, rather than the particular apparatus or method used to assemble the temporary road mat, since the apparatus and method do not provide the resulting road mat with any inherent structurally defining characteristics that differ from those of the bolted road mats of Phillips et al. and Penland, Sr.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 2, 5, 12, and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 11 of U.S. Patent No. 6,745,452 to Harrison.** Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent “anticipate” the broader application claims. Accordingly, the application claims are not patentably distinct from the patent claims. Since it is clear that the more specific patent claims encompass the application claims, following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

The application claims correspond to the patent claims as follows:

Application Claim	Patent Claim
1	1
2	1
5	4
12	11
13	11

**Claims 3, 4, and 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S. Patent No. 6,745,452 to Harrison in view of Colville (U.S. Patent No. 410,784).**

Claims 1 and 11 of Harrison teach an apparatus and method whereby the gang drill assembly is longitudinally moved with respect to a fixed assembly table, and thus fail to teach an apparatus and method whereby the timbers are moved along an assembly table via an indexing conveyor with respect to a fixed gang drill assembly to serially drill the intersections of the layered timbers.

Colville teaches a drilling apparatus and corresponding method, whereby timbers 50 are positioned upon an assembly table 45, and an indexing conveyor 46 moves the timbers along the table with respect to a fixed gang drill assembly 55 comprising a plurality of drills 60 to serially drill the holes through the conveyed timbers (see Figures 1 and 3).

Since it has been shown that relative movement between a gang drill assembly and an assembly table can be achieved through maintaining either of the units fixed while the other is movable with respect thereto, the choice between either arrangement is deemed to have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made.

**Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,745,452 to Harrison in view of Phillips et al. (U.S. Patent No. 6,523,243).**

Claim 1 of Harrison teaches all claimed features, with the exception of drill units in the

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gang drill assembly that have a first bit section for forming the through holes and a second bit section for further forming counterbores in the timbers.

Phillips et al. teach a drill bit 900 (Figure 9) that includes a first bit section 902 for drilling a through hole 802 through stacked timbers 812, 814, 818 (Figure 8B), and a second bit section 904 for forming counterbores 808 at one end of the through holes. As disclosed in column 4 (lines 52-55), the counterbores allow the bolt heads or fastening nuts to be recessed below the surface of the joined timbers. This arrangement provides the advantages noted in column 2 (lines 40-45), i.e. the nuts or bolt heads will not catch on anything to hinder the movement of the assembled timbers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the drill units of the gang drill assembly of Harrison with a first bit section for forming the through holes and a second bit section for further forming counterbores in the timbers, as taught by Phillips et al., to provide a means to recess the bolt heads in the timbers such that they will not catch on anything to hinder the movement of the assembled timbers.

**Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,745,452 to Harrison in view of Phillips et al. (U.S. Patent No. 6,523,243), as applied to claim 8 above, and further in view of Folse, Sr. (U.S. Patent No. 4,410,024).**

The Harrison/Phillips et al. combination fails to teach second drill units for forming counterbores in the lower layer of timbers.

Folse, Sr. teaches a gang drill assembly **80** (Figure 13) that is used to simultaneously form a plurality of counterbores in pre-drilled openings in timbers such that the bolt heads or nuts used to fasten multiple timbers together may be recessed within the counterbores to protect the heads or nuts from damage (column 7, lines 10-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided second drill units including counterbore forming bits therein, as taught by Folse, Sr., in a second gang drill assembly positioned beneath the stacked timbers of Harrison for forming counterbores in the pre-drilled through bores in the stacked timbers to accommodate the bolt heads and/or nuts used to fasten the timbers together in the later assembly stage.

#### *Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David P. Bryant whose telephone number is 571-272-4526. The examiner can normally be reached on Monday-Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Jimenez can be reached on 571-272-4530. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David P. Bryant  
Primary Examiner  
Art Unit 3726

dpb  
11/28/05